

SECTION III—REMARKS

This amendment is submitted in response to the Office Action mailed August 8, 2005. No claims are amended, and claims 1-22 remain pending in the application. Applicant respectfully requests reconsideration of the application and allowance of all pending claims in view of the above amendments and the following remarks.

Rejections Under 35 U.S.C. § 103

The Examiner rejected all claims in the application under 35 U.S.C § 103(a) as obvious in view of, and therefore unpatentable over, U.S. Patent No. 6,178,044 to Li *et al.* (“Li”) alone, or Li in combination with Applicant’s allegedly admitted prior art. Specifically, the Examiner rejected claims 1-3, 9-13 and 17 over Li, and rejected claims 4-8, 14-16, 18-20 and 22 over Li in view of Applicant’s allegedly admitted prior art. Applicant respectfully traverses the Examiner’s rejections.

Claim 1 recites an optical isolator combination including an input, an output, and a phase retardation plate positioned at the input, wherein the phase retardation plate “is the first polarization-modifying component encountered by an optical signal entering through the input.” The Examiner concedes that Li does not disclose that the phase retardation plate is the first polarization-modifying component encountered by the optical signal. Nonetheless the Examiner, citing *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950), alleges that it would have been obvious to one of ordinary skill in the art at the time the invention was made to place a phase retardation plate as the first component of an optical isolator, since it has been held that rearranging parts of an invention involves only routine skill in the art.

Applicant respectfully disagree. The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of applicant's specification, to make the necessary changes in the reference device. *See* MPEP § 2144.04 (VI)(C); *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). Aside from a conclusory statement that re-arranging parts is a obvious design choice, the Examiner has not shown that Li provides any motivation for re-arranging its parts to arrive at the claimed invention. In fact, the Examiner's sole motivation to re-arrange the parts—to properly adjust the polarization of the signal for its intended use—comes directly from Applicant's specification.

Li not only does not provide any motivation for re-arranging its parts, but also teaches away from such a modification. Li discloses an optical circulator in which the paths taken by different signals are critical to the circulator's operation. The paths of the signals through the circulator depend on their polarization, specifically on the particular sequence of polarization changes in the signal (*see* col. 4, lines 55-59). Thus, any modification of the sequence of polarization changes, such as would be caused by a re-arrangement of parts, would destroy the function of the circulator. Li therefore cannot obviate a combination including the claimed limitations, because Li provides no motivation for modifying its apparatus such that a phase retardation plate "is the first polarization-modifying component encountered by an optical signal entering through the input." Applicant submits that Li therefore cannot obviate the claim, and respectfully requests withdrawal of the rejection and allowance of the claim.

Regarding claim 2-8 if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 1 is in condition for allowance. Applicant submits that claims 2-8 are therefore allowable by virtue of their dependence on an allowable independent claim, as well as by virtue of the features recited therein. Applicant respectfully requests withdrawal of the rejections and allowance of these claims.

Claim 9 recites a process combination including rotating a polarization of an optical signal using a phase retardation plate, “wherein the phase retardation plate is the first polarization-modifying component encountered by the optical signal.” By analogy to the discussion above for claim 1, Li does not disclose, teach or suggest a combination in which a phase retardation plate is “the first polarization-modifying component encountered by the optical signal,” and in fact teaches away from re-arranging its parts to arrive at the claimed combination. Applicant submits that Li therefore cannot obviate the claim, and respectfully requests withdrawal of the rejection and allowance of the claim.

Regarding claim 10-15 if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 9 is in condition for allowance. Applicant submits that claims 10-15 are therefore allowable by virtue of their dependence on an allowable independent claim, as well as by virtue of the features recited therein. Applicant respectfully requests withdrawal of the rejections and allowance of these claims.

Claim 16 recites a system combination including an optical signal source and an optical isolator having an input and an output, the optical signal source being coupled to

the input, and the optical isolator comprising a phase retardation plate positioned at the input, wherein the phase retardation plate “is the first polarization-modifying component encountered by the optical signal.” By analogy to the discussion above for claim 1, Li does not disclose a combination where the phase retardation plate “is the first polarization-modifying component encountered by the optical signal,” and teaches away from a rearrangement of its parts that would result in the claimed combination. Applicant submits that the combination of Li with the prior art disclosure of the present application therefore cannot obviate the claim, and respectfully requests withdrawal of the rejection and allowance of the claim.

Regarding claims 17-22, if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is also non-obvious. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). As discussed above, claim 16 is in condition for allowance. Applicant respectfully submits that claims 17-22 are therefore allowable by virtue of their dependence on an allowable independent claim, as well as by virtue of the features recited therein. Applicant respectfully requests withdrawal of the rejections and allowance of these claims.

Conclusion

Given the above amendments and accompanying remarks, all claims pending in the application are in condition for allowance. If the undersigned attorney has overlooked a teaching in any of the cited references that is relevant to allowance of the claims, the Examiner is requested to specifically point out where such teaching may be found. Further, if there are any informalities or questions that can be addressed via telephone, the Examiner is encouraged to contact the undersigned attorney at (206) 292-8600.


Charge Deposit Account

Please charge our Deposit Account No. 02-2666 for any additional fee(s) that may be due in this matter, and please credit the same deposit account for any overpayment.

Respectfully submitted,

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Date: 10-7-05



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